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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/579,603	05/17/2006	Hironobu Ishiwatari	59125US004	4782
32692 7590 08/21/2008 3M INNOVATIVE PROPERTIES COMPANY PO BOX 33427 ST. PAUL, MN 55133-3427				
EXAMINER KATZ, VERA				
ART UNIT 4152		PAPER NUMBER		
NOTIFICATION DATE 08/21/2008		DELIVERY MODE ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

LegalUSDocketing@mmm.com

LegalDocketing@mmm.com

# Office Action Summary

**Application No.**

10/579,603

**Applicant(s)**

ISHIWATARI ET AL.

**Examiner**

VERA KATZ

**Art Unit**

4152

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SF/88)  
Paper No(s)/Mail Date 1/22/2007
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_

## **DETAILED ACTION**

### ***Information Disclosure Statement***

1. The information disclosure statement filed 1/22/07 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each cited foreign patent document; each non-patent literature publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered. The document WO 98/13199 was missing from the application.

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1- 7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1 and 2 recited stress characteristics measured according to Japanese Industrial Standards (JIS K7115). However, these standards and the conditions are subject to changes over the years, especially during the patent terms plus 8 years and also after. The public will not be able to appreciate and follow these specific conditions for testing the stress.

Claims 1(a) and (b) and 2 are indefinite because they fail to set forth the composition or structure of the tape and only claim properties of the tape. Claims that

merely set forth physical characteristics desired in an article, and not setting forth specific compositions which would meet such characteristics are invalid as vague, indefinite, and functional since they cover any conceivable combination of ingredients either presently existing or which might be discovered in the future. Ex parte SLOB, 157 USPQ 172 (Bd. Pat. App. & Int. 1967).

### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-7 are rejected under 35 U.S.C. 103(a) as being obvious over Everaerts (US 5,695,837) in view of Scholz (US 2002/0170465).

According to claim 1, Everaerts teaches a single coated adhesive tape (see claim 18 of column 21,) comprising an adhesive layer having a thickness of 30 to 1000 µm (example 15, recites a thickness of 100 µm) which contains 50 to 95% by weight of a hot melt adhesive and 5 to 50% by weight of a film forming component (art teaches 25-99 parts by weight of polymerizable component (a) and 0 to 75% by weight of polymerizable component (b) tackifier is of 1 to 75 parts by weight per 100 parts by weight of the sum of a polymerizable component a and component b; see abstract, also disclosed is that the adhesives of the invention can be formulated to be hot melt

adhesives, col. 8, lines 39-40) and a non-tacky coating on one surface of said adhesive layer. Everaets discloses a non-tacky coating layer; see claim 18 of col.21.

Everaets does not appear to explicitly disclose the thickness of the liner.

However, Scholz (US 2002/0170465) discloses the thickness of the non-tacky coating (release liner) in the range of about 0.5 to 10  $\mu\text{m}$ ; see [0100], which is within the applicant's range of the thickness of 0.01 to 15  $\mu\text{m}$ .

Both Everaets and Scholz are analogous art because they are from the same field of endeavor: coated adhesive tapes.

At the time of the invention, it would have been obvious to one of ordinary skill in the art, having the teaching of Everaets and Sholz before him or her, to modify the thickness of the reference A to include the thickness of about 0.5 to 10  $\mu\text{m}$  to decrease the force and bond to peel it. [0003], [0008], [0100] and [0109].

As to the stress characteristics, recited in the claim 1, it would have been obvious that the same adhesive formulations having the same thickness used in the same areas would possess the same stress characteristics.

Regarding claim 2, please see the arguments immediately above.

As to claim 3, Everaets recites a melt adhesive comprises a polymer of at least one monoethylenically unsaturated methacrylic acid ester comprising an alkyl group having at least 4 carbons. (Recited: methacrylic ester....wherein alkyl group contains 4-20 carbon atoms, see abstract also see col. 6, lines 11-20 for examples of monofunctional methacrylic acid esters).

And at least one monoethylenically unsaturated reinforcing monomer; see col.6, line 21, reciting a monoethylenically unsaturated reinforcing co-monomer.

As to claim 4, hot melt adhesive contains a rubber-based adhesive; see col. 10, lines 23-25: The second adhesive may be...synthetic rubber, natural rubber a hot melt or thermosettable.

As to claim 5, a film forming component is composed of a thermoplastic resin having a softening point within a range from 25 to 300 °C. (Recited as range of 65 °C to 125 °C, see the abstract.)

As to claim 6, see col.13 line 7 and col.9, line 65, reciting polyamide and cellulose, respectively.

As to claim 7, non-tacky coating layer is transparent, col.8, line 61; see also abstract reciting clear and essentially colorless adhesive.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure is cited in the PTO-892 form.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to VERA KATZ whose telephone number is (571)270-7082. The examiner can normally be reached on M - Th 7:30 -5, F 7:30-4.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, JOSEPH DEL SOLE can be reached on 571-272-1130. The fax phone

number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/VERA KATZ/  
Examiner, Art Unit 4152

/Joseph S. Del Sole/  
Supervisory Patent Examiner, Art Unit 4152